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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,163	07/03/2003	Peter David Davis	215233.00107	4150
27160	7590	06/13/2005	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP 525 WEST MONROE STREET CHICAGO, IL 60661-3693			JIANG, SHAOJIA A	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/612,163

Applicant(s)

DAVIS, PETER DAVID

Examiner

Shaojia A. Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 10-41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Supplemental Election/Restrictions

This application is a continuation of 09/889,061 filed 10/22/2001, now US patent 6,645,950 which is a 371 of PCT/GB00/00099 filed 01/14/2000, which claims the foreign priority UNITED KINGDOM 9900752.8 filed 01/15/1999 under 35 U.S.C. 119(a)-(d).

Applicant's preliminary amendment submitted July 3, 2003 is acknowledged wherein the abstract has been amended; Claims 1-9 have been cancelled and claims 10-41 are newly submitted.

Currently, claims 10-41 are pending in this application.

Applicant's election of the invention of Group II, claims 11-41 and of the invention of the species wherein Y is NHC(O)R₄ and R₄ is 1-aminoalkyl, submitted March 25, 2005 is acknowledged.

On consideration by the examiner, the specie election requirement dated March 25, 2005, is withdrawn.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim 10 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

However, in view of the instant claims read on numerous patentably distinct agents, the Supplemental Restriction Requirement as follows:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 11-15 drawn to a method for treatment or prophylaxis of a disease or condition involving angiogenesis in a mammal wherein a composition of Claim 8 is administered to said mammal in a dosage sufficient to damage new vasculature but insufficient to exhibit anti-mitotic activity, comprising the step of administering to said patient a compound represented by Structural Formula (I), classified in class 514, subclass 385, 387, 388 and 391 for example. Note that claim 8 has been cancelled.
- II. Claims 16-18 drawn to a method for treatment or prophylaxis of a solid cancerous tumor in a mammal wherein a composition of Claim 10 is administered to said mammal in a dosage sufficient to damage new vasculature but insufficient to exhibit anti-mitotic activity, comprising the step of administering to said patient a compound represented by Structural Formula (I), classified in class 514, subclass 385, 387, 388 and 391 for example. Note that claim 10 has been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
- III. Claims 19 in part, 20 in part, 21, and 32, 31 in part drawn to a method in Group II further comprising a mitotic inhibitor, classified in class 514, subclass +1.

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- IV. Claims 19 in part, 20 in part, 22, and 33, 31 in part drawn to a method in Group II further comprising an alkylating agent, classified in class 514, subclass +1.
- V. Claims 19 in part, 20 in part, 23, and 34, 31 in part drawn to a method in Group II further comprising an antimetabolite, classified in class 514, subclass +1.
- VI. Claims 19 in part, 20 in part, 24, and 35, 31 in part drawn to a method in Group II further comprising an intercalating agent, classified in class 514, subclass +1.
- VII. Claims 19 in part, 20 in part, 25, and 36, 31 in part drawn to a method in Group II further comprising an enzyme,, classified in class 514, subclass +1.
- VIII. Claims 19 in part, 20 in part, 26, and 37, 31 in part drawn to a method in Group II further comprising a topoisomerase inhibitor, classified in class 514, subclass +1.
- IX. Claims 19 in part, 20 in part, 27, and 38, 31 in part drawn to a method in Group II further comprising a thymidylate synthase inhibitor, classified in class 514, subclass +1.
- X. Claims 19 in part, 20 in part, 28, and 39, 31 in part drawn to a method in Group II further comprising a biological response modifier, classified in class 514, subclass +1.

- XI. Claims 19 in part, 20 in part, 29, and 40, 31 in part drawn to a method in Group II further comprising an antibody, classified in class 514, subclass +1.
- XII. Claims 19 in part, 20 in part, 30, and 41, 31 in part drawn to a method in Group II further comprising an anti-hormone, classified in class 514, subclass +1.

Inventions Group I to XII are unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the inventions are separate and distinct each from the other since they have different modes of operations and different functions, for example the mode of operation and function of an antibody in combination with the compound herein is separate and distinct from the mode of operation and function of an anti-hormone in combination with the compound.

Moreover, the function and mode of the method for treating a solid cancerous tumor in a mammal is separate and distinct from the mode of operation and function of a disease or condition involving angiogenesis in a mammal.

Each method of treatment relates to a separate and distinct area of pharmaceutical technology. The search for all inventions would place an undue burden on the examiner in view of the diversity of the medical disorders to be treated and the corresponding diversity in the field of search for each.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

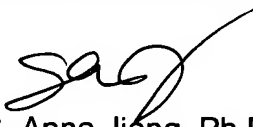
Because the above restriction/election requirement is complex, a telephone call to applicant's agent to request an oral election was not made. See M.P.E.P Sec. 812.01. In view of the rejections to the pending claims set forth above, no claims are allowed.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Anna Jiang, Ph.D.
Primary Examiner
Art Unit 1617
June 6, 2005